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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,939	12/18/2000	J. Seth Blumberg	16808-19	4782

7590

01/31/2005

Sidley Austin Brown & Wood LLP  
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Los Angeles, CA 90013

EXAMINER

HENNING, MATTHEW T

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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07/15/2004

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EXAMINER

HENNING, MATTHEW T

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**JUL 29 2004**

**Technology Center 2100**

**Office Action Summary**

Application No.

09/739,939

Applicant(s)

BLUMBERG, J. SETH

Examiner

Matthew T Henning

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 December 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) 2-6, 8-10, 12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

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**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

This action is in response to the communication filed on 12/18/2000.

**DETAILED ACTION**

1. Claims 1-12 have been examined.

***Title***

2. The title of the invention is acceptable.

***Priority***

3. The application has been filed under Title 35 U.S.C §119(e), claiming priority to provisional application 60/171,035, filed December 16, 1999.
4. The effective filing date for the subject matter defined in the pending claims in this application is December 16, 1999.

***Information Disclosure Statement***

5. No IDS has been submitted for this application.

***Drawings***

6. The drawings filed on 12/20/2000 are not acceptable for examination proceedings.
7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Figure 4. Corrected drawing sheets, or amendment to the specification to add the reference character(s) in the description, are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be

labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Specification**

8. Applicant is reminded of the proper language and format for an abstract of the disclosure.

*The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.*

*The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.*

9. The abstract of the disclosure is objected to because

Line 1: "Firewall Protection in Computer Network Systems" must be removed, as it is not a proper heading for the Abstract of the Disclosure.

Correction is required. See MPEP § 608.01(b).

10. The disclosure is objected to because of the following informalities:

Paragraph 3 Line 9 recites "or the and" which is grammatically incorrect;

Paragraph 4 recites "the new 10024 bit security system" which is incorrect and should refer to the 1024 bit system;

Paragraph 6 defines the term "physically separate" three different ways;

Paragraph 22 recites "the machin of the Internet" which is unclear because the Internet is not one machine, and is in fact many machines working together to form a communication network (this recitation is used throughout the specification and all occurrences must be corrected).

Paragraph 42 Line 1 references element 188, which does not correspond with the memory bus 118.

Appropriate correction is required.

### ***Claim Objections***

11. The applicant is reminded that a series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

12. Claims 2-6, 8-10, and 12 are objected to because of the following informalities:

Claim 2 recites "the the essentially sole" on lines 2-3;

Claim 2 requires a ':' after the word "comprising" in order to separate the preamble from the body of the claim;

Claim 3 Line 3 recites "server or computer or router or switch or other computer", in which the limitation "computer" and "other computer" are redundant;

Claim 3 Line 8 recites the misspelled word "physcialy";

Claim 5 Line 1 recites the misspelled word "acc4sses";

Claim 6 Lines 2 and 3 both recite "solid state devices" which is redundant;

Claim 6 Line 6 recites "the remote user effect the connectivity" which grammatically incorrect. The examiner will assume the limitation was meant to read "the remote user affecting the connectivity";

Claim 11 Line 7 recites "from selectively from" which is grammatically incorrect.

Any claim not specifically addressed above is objected to by virtue of its dependency.

Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

13. 35 U.S.C. 101 reads as follows:

*Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.*

14. Claim 11 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 11 recites "software for directing at least one of the simultaneous or successive remote connections or disconnections of a physically remotely located computer;" which is simply software and nothing statutory, as well as "means for allowing the user to confirm a disconnection, selectively physical, of the user computer from selectively from at least one of the Internet or another local area network." The applicant disclosed this means as the user visually confirming the disconnection (See Disclosure Page 6 Paragraph 1). This is nothing more than an

abstract idea and in no way can be considered statutory. Therefore, claim 11 is rejected for being directed at non-statutory subject matter

15. To expedite a complete examination of the instant application claim 11, rejected under 35 U.S.C. 101 (nonstatutory) above, is further rejected, as set forth below, in anticipation of applicant amending this claim to place it within the four statutory categories of invention.

***Claim Rejections - 35 USC § 112***

16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

17. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

18. The claims are generally narrative and indefinite, failing to conform to current U.S. practice and they are replete with grammatical and idiomatic errors. Because of these errors it is impossible to determine the invention behind the claim language and therefore the claims fail to particularly point out and distinctly claim the subject matter that the applicant regards as his invention. Claims 1-12 are rejected. When applying prior art, the examiner has interpreted the claims as reasonably as possible. The examiner also notes that the claimed invention and the specified invention, although similar in nature, seem to be two completely different inventions. In particular, the specified invention seems to be a router which, for security purposes, never stores and



information passed through it and is never connected to more than one network or computer, whereas the claimed invention seems to be more of a physical switch that can be remotely activated in order to allow communication between two computers.

19. Claim 1 recites "a first computer" on Line 1, Line 6, and again on Lines 11-12. It would be unclear to the ordinary person skilled in the art whether these are the same "first computer" or if they are three different computers. Also, it is unclear to which computer the recitation of "the first computer" on Line 7 is referring. Therefore claim 1 fails to particularly point out and claim the subject matter the applicant regards as his invention.

20. Claim 2 recites the limitation "a security system" on Lines 1 and 5. It would be unclear to the ordinary person skilled in the art whether these are the same "security system" or if they are different security systems. Therefore claim 2 fails to particularly point out and claim the subject matter the applicant regards as his invention.

21. Claim 7 recites the limitation "the machine of the Internet" on Line 1. This limitation renders the scope of the claim indeterminate due to the fact that the ordinary person skilled in the art would not be able to determine what "the machine" encompasses. The machine may encompass only a particular computer, or it may encompass every computer, router, switch, bridge, etc. connected to the Internet. Therefore, one of ordinary skill in the art could not determine if they were infringing on the scope of this claim.

22. Claim 2 recites the limitation "the necessary software" in Lines 4-5.

Claim 11 recites the limitation "the simultaneous or successive remote connections or disconnections" in Lines 3-4.

Claim 11 recites the limitation "the user" in Line 6.

Claim 12 recites the limitation "the device" in Line 1.

There is insufficient antecedent basis for these limitations in their respective claims.

***Claim Rejections - 35 USC § 102***

23. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

24. Claims 1-3, 5-6, and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Caudill et al. (U.S. Patent Number 3,984,637) hereinafter referred to as Caudill.

25. Claim 1 recites a security means physically separated from a main computer (See Caudill Fig. 1 Elements 11, 24, 25, 26, and 29), the security means being for safeguarding and securing a first computer (Element 28) and wherein the security means is physically separated from the first computer and wherein physically separated includes at least one of not being hardwired, or infrared linked to the first computer (See Fig. 1 Element 28 and Elements 24, 25, 26, and 29 wherein the computer is not hardwired or infrared linked to the code receiver), wherein the security means does not

contain essentially any software other than software required for a single transmission of data or communication to be downloaded (inherent in the drivers for modems 18 and 21 in order for data communication to take place) from a first computer (Element 15) to the security means (See Abstract Lines 11-14).

26. Claim 2 recites a security system for increasing security between a main computer (28) and a network (anything left of element 21) wherein the security system includes only minimal circuitry, the circuitry being for the essentially sole purpose of operating the security system (See Fig. 4), the security system comprising hardware for operating the security system (See Fig. 4) and wherein after each use of the security system, the necessary software (See Abstract Lines 11-14) of a security system downloaded from a user's computer (11 and 15) or a main computer is selectively erased from the security system (See Col. 2 Lines 30-31 and Element 29 wherein it was inherent that after every use, either the system was reset through switch 29 or it was not reset).

27. Claim 12 recites the use of the device without disturbing or corrupting any technical elements of the network architecture or systems architecture. It was inherent that the network and systems architecture were not corrupted in the security system of Caudill. This was inherent because if they were corrupted, the terminal would not be able to communicate with the computer as disclosed by Caudill (See Col. 2 Paragraph 3)

28. Claim 3 recites means for physically selectively disconnecting or connecting the connection (Element 27) with a first computer (Element 28) from a computer of a user

(Element 11). Caudill disclosed being able to close a switch (27) in order to connect the terminal (11) to the computer (28) (See Col. 2 paragraph 3) and being able to reset the code receiver (25) which resets the switch (27) by using another switch (29) (See Col. 2 Lines 30-31).

29. Claim 5 recites the user accesses the first computer (28) from a remote location (11) through access to the Internet or other network (19) thereby to selectively connect (Col. 2 Paragraph 3) and disconnect (See Col. 2 Lines 30-31) the first computer (See Fig. 1 which depicts the terminal 11 and the switch 29 being remote from the computer 28) without substantially effecting the network architecture or codes in routers or other computer apparatus associated with the operation of the first computer. It was inherent that the network architecture or codes in routers or other computer apparatus associated with the operation of the computer (28) were not substantially affected in the security system of Caudill. This was inherent because if they were substantially affected, the terminal would not be able to communicate with the computer as disclosed by Caudill (See Col. 2 Paragraph 3)

30. Claim 6 recites the security system comprising a device, selectively being a solenoid (Element 26), solid state devices (resistors throughout Fig. 4), chip based devices, liquid based devices, chemical based devices, other electronic devices (all elements in all figures of Caudill), fuel based engines, fuel cell devices, for physically detaching at least one of the fiber, copper, or other data transfer cable or connectivity (Switch 27), and means for the device to receive a signal from the remote user affecting the connectivity (Col. 2 Paragraph 3).

31. Claim 11 recites a computerized system having security for network communications comprising: software for directing at least one of the simultaneous or successive remote connections or disconnections of a physically remotely located computer, means for allowing the user to confirm a disconnection, selectively physical, of the user computer from selectively from at least one of the Internet or another local area network (See Abstract Lines 11-18 and Element 27). Although Caudill did not specifically disclose confirming the disconnect, he did disclose disconnecting the computer for security purposes via a switch (29) (See Col. 2 lines 30-31). Further, it was inherent that the user was allowed to confirm the disconnection of switch 27 by visually confirming that the switch was in the open position. This was inherent because it was a natural mental step when disconnecting something for a user to check the disconnection by looking at the connecting location.

***Claim Rejections - 35 USC § 103***

32. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

33. Claims 4, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caudill as applied to claim 3 above, and further in view of Clark et al. (U.S. Patent Number 3,949,364) hereinafter referred to as Clark.

Caudill disclosed a system for connecting and disconnecting a remote terminal to a computer involving authorization by entering a code (See Caudill Abstract), but failed to disclose the possible uses of such a system.

Clark teaches a need in the field of banking for unmanned customer service facilities remote from main buildings but available at all times to customers establishing authorized identity, while providing maximum security at minimum cost at all times for the stored money involved in the transactions to be carried out at any unmanned remote customer station (See Clark Col. 2 Paragraph 3).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Clark to the invention of Caudill in order to provide a use for the computer terminal security system. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide the security of Caudill with the convenience of unmanned remote banking terminals.

34. Regarding claim 4, if the remote switch (Element 29 of Caudill) was pressed, the computer of the bank (Element 28 of Caudill) was disconnected from the network at a separate switch (Element 27 of Caudill) and all information and monies contained therein were then secure.

35. Claim 9 recites the user selectively updates a bank record or balance updated, or other action requiring electronic security or privacy (See Clark Col. 8 Paragraph 5 where Clark disclosed withdrawing money), simultaneously as the user's computer authorizes and records the data transfer. It was inherent that when money was withdrawn, from the remote customer service facility, that the transaction was recorded. This was

inherent because the bank must know how much money each account has in order to function as a bank.

36. Claim 8 recites the computer includes a database of bank records of transfers and other electronic security sensitive data, and wherein transmissions are authorized and/or approved and/or recorded or data stored regarding such data transfer or transmission (See Clark Col. 10 Paragraph 2).

37. Claim 10 recites when the computer of a bank is not disconnected, then a bank transfer is not authorized. Caudill showed that the computer is always disconnected from the Code Receiver (25) (See Caudill Fig. 1). Therefore, all transactions that were authorized occurred when the computer is disconnected, and any connection between the code receiver and the computer would have required a breach in security, and therefore would have been unauthorized.

38. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caudill, and further in view of Rao et al. (U.S. Patent Number 5,805,636) hereinafter referred to as Rao.

Caudill disclosed a system for connecting and disconnecting a terminal to a computer (See Rejection of Claim 3 above) but failed to disclose the possibility of connecting the terminal to multiple computers at the same time or in any order.

Rao teaches that in order to send data, voice, and video communications, a computer can create three separate connections in any order, simultaneously, or not (See Rao Abstract and Fig. 3).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Rao in the invention of Caudill in order to make multiple connections from one terminal. This would have been obvious because the ordinary person skilled in the art would have been motivated to provide simultaneous voice, data, and video connections in order to provide the terminal with teleconference capabilities.

***Conclusion***

39. Claims 1-12 have been rejected.

40. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Hughes (U.S. Patent Number 4,604,499) disclosed a telephone switching system for connecting two computers via a modem.
- b. Leal (U.S. Patent Number 4,707,804) disclosed a computer security system comprising a switching unit and a security computer for connecting and disconnecting communication lines
- c. Mansvelt et al. (U.S. Patent Number 5,175,416) disclosed a method of secure funds transfer involving smartcards and multiple data connections.

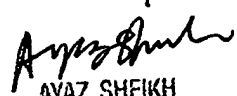


41. Please direct all inquiries concerning this communication to Matthew Henning whose telephone number is (703) 305-0713. The examiner can normally be reached Monday-Friday from 9am to 4pm, EST.

If attempts to reach examiner by telephone are unsuccessful, the examiner's acting supervisor, Ayaz Sheikh, can be reached at (703) 305-9648. The fax phone number for this group is (703) 305-3718.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Matthew Henning  
Assistant Examiner  
Art Unit 2131

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100

<b>Notic of References Cited</b>	Application/Control N . 09/739,939	Applicant(s)/Patent Under Reexamination BLUMBERG, J. SETH	
	Examiner Matthew T Henning	Art Unit 2131	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-3,984,637	10-1976	Caudill et al.	379/93.02
	B	US-3,949,364	04-1976	Clark et al.	235/375
	C	US-5,805,636	09-1998	Rao et al.	375/222
	D	US-4,707,804	11-1987	Leal, Luis T.	340/5.33
	E	US-5,175,416	12-1992	Mansvelt et al.	235/379
	F	US-4,604,499	08-1986	Hughes, Lawrence R.	379/93.02
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.